

### **REMARKS**

The Examiner has rejected claims 1, 2, 4, 13, 15 and 17-19 under 35 U.S.C. § 102(b) as being anticipated by Torino U.S. Patent No. 2,653,598. Claims 1 and 4-5 are rejected under § 102(b) as being anticipated by Wagner U.S. Patent No. 5,611,687. Claims 3, 6, 14 and 16 are rejected under § 103(a) as being unpatentable over Torino in view of Varaine U.S. Patent No. 5,118,291. Claims 7-12 are rejected under § 103(a) as being unpatentable over Torino in view of Watmough et al. U.S. Patent No. 4,735,604. Claims 20-21, 23-26, 38, 40, 42-43, and 45 are rejected under § 103(a) as being unpatentable over Torino. Claims 22, 27, 39, 41, 44 and 46 are rejected under § 103(a) as being unpatentable over Torino, and further in view of Varaine. Claims 28-37 are rejected under § 103(a) as being unpatentable over Torino, and further in view of Watmough et al. Claims 47-59 are rejected under § 103(a) as being unpatentable over Torino in view of Varaine, and further in view of Watmough et al. The following remarks are respectfully submitted.

Claim 1 has been amended to particularly describe that only the proximal end of the roller tip is rotatably mounted on the working end, and the distal end extends away from the working end. This amendment has support in FIGs. 1-5 and does not represent new matter. In addition, the term "distal tip portion" is used in the specification with reference to parts 28a, 28b, 28c, and "distal" by definition refers to a part that is situated away from the point of attachment. If there is a distal portion, there is inherently a proximal portion, which by definition is situated toward the point of attachment. These terms are well understood in the art, and thus, no new matter is added by use of these terms.

With respect to the rejection of claims 1, 2, 4, 13, 15 and 17-19 under 35 U.S.C. § 102(b) as being anticipated by Torino, Applicants respectfully traverse. In Torino, both ends of the gum-massaging drum, which the Examiner equates to a "roller tip," are attached to the working end. There are no distal and proximal ends. Because each and every limitation in a claim must be taught by the reference for the reference to anticipate the claim, and Torino does not teach a roller tip mounted at a proximal end with a distal end extending away from the working end, Applicants respectfully request withdrawal of the rejection of claim 1 and its

dependent claims 2, 4, 13, 15, and 17-19 based on Torino. Furthermore, claim 1 has also been amended to recite that the first roller tip is rotatable about the center axis of the first working end. This is distinguished from Torino where the gum massager drum rotates on an axis perpendicular to the center axis of the working end. For this additional reason, Applicants respectfully request withdrawal of the rejection of claims 1, 2, 4, 13, 15 and 17-19 based on Torino.

The Examiner has rejected Claims 1 and 4-5 under § 102(b) as being anticipated by Wagner U.S. Patent No. 5,611,687. Claim 4 is cancelled herein. Amended claim 1 (see above) and dependent claim 5 each recite that rotation of the roller tip is about the center axis of the first working end. Claim 5 further recites the center axis of the working end is coaxial with the center axis of the handle portion. Wagner discloses the use of a “roller ball” applicator. However, the roller ball is not mounted at a proximal end with a distal end extending away and it does not have a fixed axis of rotation but can rotate along many axes. Because Wagner does not teach each and every element of the claimed invention of claims 1 and 5, Applicants respectfully request withdrawal of the rejection.

With respect to the rejection of claims 3, 6, 14 and 16 under § 103(a) as being obvious over Torino in view of Varaine, Applicants respectfully traverse. Torino discloses a combination toothbrush and gum massager and, as noted above, the gum massager is a drum mounted at both ends perpendicular to the center axis of the handle, with neither end being proximal or distal. In contrast, Varaine discloses an instrument having an eraser removably fixed in one end thereof to “erase deposits and stains on teeth simply by rubbing the eraser on the surface of the teeth.” The fact that the eraser is removably fixed as opposed to removably rotatable is essential to the operability of the device for its intended purpose. If the eraser were to rotate as it is moved across the surface, it would not be able to rub deposits and stains off the surface, but instead would simply roll right over them. Therefore, there is no teaching or suggestion to combine these two references. Furthermore, with regard to the shape and plurality of tips, Varaine provides interchangeable eraser tips of “different shapes in order to constitute work surfaces which are also different.” However, the device disclosed by Torino is a drum that is rolled over the gums and therefore, there is no need or suggestion to get the “roller tip” into

crevices or relatively inaccessible places, and a tapered tip would actually interfere with smooth, even rolling of the drum over the gums. As the device disclosed by Torino is designed to massage the gums, providing a smooth, even rolling action and maximizing surface contact between the roller drum and the gums is essential. Alternate shapes for the roller drum would not achieve this, and would be contrary to its purpose. For two references to be combined, there must be a teaching, suggestion or motivation to combine them, which is lacking with regard to the proposed combination of the Torino and Varaine references. Moreover, there must be a reasonable expectation of success. There is no such expectation here, and in fact, the combination is contrary to the intended purposes of both references. Therefore, the Applicants respectfully request that the rejections of claims 3, 6, 14, and 16 be withdrawn.

With respect to the rejection of claims 7-12 under § 103(a) as being obvious over Torino in view of Watmough et al., Applicants respectfully traverse. Claims 7-12 depend directly or indirectly from claim 1. The deficiencies of Torino with respect to claim 1 are described above. Watmough et al. do not teach or suggest the missing elements of Torino. Because the combination of references does not teach or suggest each element of the claimed invention, the rejection cannot stand. Moreover, Watmough et al. disclose a "surgical aspirator" that has a tip that vibrates and thus "chops" through the tissue. The tip of the surgical aspirator goes through an end bush, whereby the end bush is composed of a material having a low coefficient of friction, such as polytetrafluoroethylene (ptfe). According to the Examiner, "it would have been obvious to modify the device of Torino with a coating of polytetrafluoroethylene, as taught by Watmough et al., since it is known that polytetrafluoroethylene is an ideal material to decrease friction between moving parts, such as in bushings." However, Torino actually teaches away from the proposed modification. Torino discloses means to increase the friction of the roller drum, thereby increasing the massaging pressure. For instance, Torino states that "friction washers of rubber or like material, are positioned ... so as to resist free rotation of the drum .... Tightening the parts ... will increase the effect of the friction washers and increase the pressure against the gums ...." (col. 4, lines 28-38). Torino also states that rotation can be controlled by "manually squeezing the outer end

portions of the arms together ... causing the frictional contact ... to be increased to resist free rotation of the drum" (col. 3, lines 52-64). There is no teaching, suggestion or motivation to combine references to arrive at the claimed invention where the reference teaches against the proposed modification. Because there is no *prima facie* case of obviousness, Applicants respectfully request withdrawal of the rejections to claims 7-12.

With respect to the rejection of claims 20-21, 23-26, 38, 40, 42-43, and 45 under § 103(a) as being obvious over Torino, Applicants respectfully traverse. Claim 20 has been amended herein in a manner consistent with the amendment to claim 1 from which it depends. Claims 21 and 23-25 depend from claim 20, directly or indirectly. Claim 26 has also been amended herein in a manner consistent with the amendment to claim 1. Claims 38, 40, 42-43 and 45 depend from claim 26, directly or indirectly. Examiner states that:

"Torino discloses the claimed invention with the exception of a second working end and roller tip according to the same specifications as listed above. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Torino having a plurality of roller assemblies, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art" (06/14/06 Office Action, pg. 5).

For the same reasons presented above with respect to claim 1, Torino fails to teach or suggest the claimed invention as amended herein. Specifically, Torino does not teach or suggest mounting the roller tip at a proximal end with a distal end extending away from the working end, and the tip being rotatable about the center axis of the working end. In addition, the purpose of Torino's device, as stated by Torino, is a "... combined toothbrush and gum massager embodying a single handle ... so that one end of the handle can be used to brush the teeth after which the handle can be turned end for end so that the drum can be used for massaging and exercising the gums ..." (col. 1, lines 5-15). Thus, putting gum massagers on each of the two working ends of Torino's device would directly contradict its stated purpose because it would require removal of the toothbrush functional end. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no

suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). Therefore, Applicants respectfully request withdrawal of the rejections to claims 20-21, 23-26, 38, 40, 42-43, and 45.

With respect to the rejection of claims 22, 27, 39, 41, 44 and 46 under § 103(a) as being obvious over Torino, and further in view of Varaine, Applicants respectfully traverse. These claims depend directly or indirectly from claims 20 or 26, which have been amended as described above. The same arguments concerning the deficiencies of Torino presented above for claims 20 and 26 apply equally to this rejection. Varaine in combination with Torino does not cure these deficiencies. Applicants further refer to the above arguments concerning the Varaine reference in the rejection of claims 3, 6, 14 and 16. There is no teaching or suggestion to modify the gum massager in Torino’s device with the attributes of the eraser tip of Varaine’s device, and doing so would not result in the claimed device. Thus, for the reasons summarized here and discussed in detail above, Applicants respectfully request withdrawal of the rejection to claims 22, 27, 39, 41, 44 and 46.

With respect to the rejection of claims 28-37 under § 103(a) as being obvious over Torino, and further in view of Watmough et al. Applicants respectfully traverse. Claims 28-37 depend directly or indirectly from claim 26, and the same deficiencies of Torino as discussed above apply here. Watmough et al. fail to cure these deficiencies. In addition, as discussed in detail above pertaining to the rejection of claims 7-12, a main feature of Torino’s device is the gum massager, whose massaging ability can be increased by increasing the friction between the roller and the working end and alternatively, decreasing the ability of the massaging drum to freely rotate. Thus, Torino teaches against the modification proposed by the Examiner, and there is no requisite motivation to combine these references. Thus, Applicants respectfully request withdrawal of the rejections for claims 28-37.

With respect to the rejection of claims 47-59 under § 103(a) as being obvious over Torino in view of Varaine, and further in view of Watmough et al., Applicants respectfully traverse. Claim 47 has been amended in a manner consistent with the amendments to claims 1 and 26, and therefore, Applicants point to the above arguments concerning the combination of

Application No. 10/736,262  
Response dated October 13, 2006  
to Office Action mailed June 14, 2006

Torino with either Varaine or Watmough. Because there is no teaching, suggestion or motivation to combine the references, and the combination does not result in a device having each and every element of the claimed invention, Applicants respectfully request that the rejection of claims 47-59 be withdrawn.

In view of the foregoing amendments to the claims and remarks given herein, Applicants respectfully believe this case is in condition for allowance and respectfully request allowance of the pending claims. If the Examiner believes any detailed language of the claims requires further discussion, the Examiner is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicants are of the opinion that no additional fee is due as a result of this Amendment. Applicants are also of the opinion that a one-month extension of time is due with this Amendment. Payment of all charges due for this filing is made on the attached Electronic Fee Sheet. If any additional charges or credits are necessary to complete this communication, please apply them to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS LLP.

By: /Kristi L. Davidson/

Kristi L. Davidson, Reg. No. 44,643

2700 Carew Tower  
441 Vine Street  
Cincinnati, OH 45202  
513/241-2324 (voice)  
513/241-6234 (facsimile)

K:\HAWES\US\response\_to\_06-14-06\_OA.doc